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Although these claims are rejected in three separate rejections, each rejection relies on the same combination of references (i.e., Weaver, Hannah and Corbin). Therefore, the rejections are traversed together in view of the following remarks.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Claims 1, 7, and 22 each recites a laminated roofing shingle comprising an overlay and an underlay. The overlay has at least one tab having a *first shadow line* and a remaining portion with granules disposed thereon in a manner whereby the first shadow line is substantially *darker in color* than the remaining portion. The underlay has a leading edge, a second shadow line, and a remaining portion between the leading edge of the underlay and the second shadow line. The leading edge of the underlay generally co-aligns with the leading edge of the tab. The underlay has an exposed portion through openings adjacent the tabs.

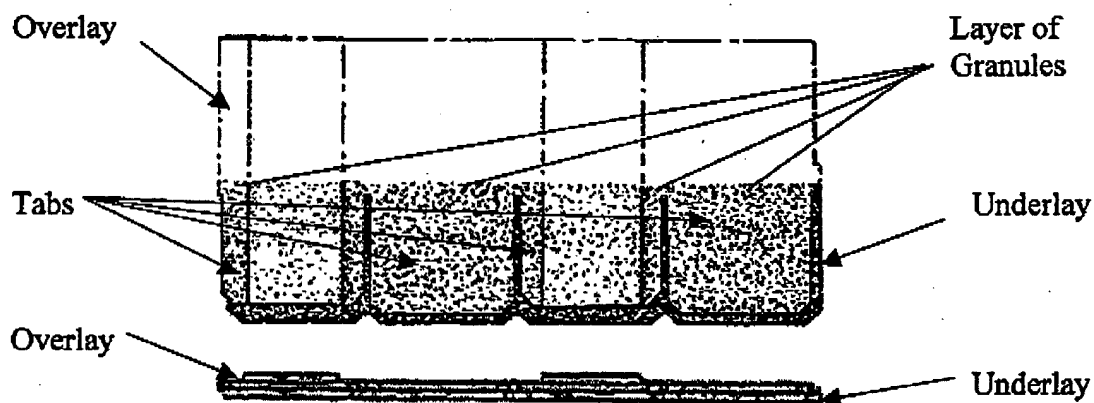
As admitted by the Examiner, on page 3 of the Official Action, Weaver *fails to teach* a tab having a *first shadow line* and a remaining portion, wherein the first shadow line is substantially *darker in color* than the remaining portion of the tab.

For the teaching of a tab having a *first shadow line* and a remaining portion, as set forth in the claims, the Examiner relies on Hannah, asserting that Hannah shows strips with tabs with a first shadow line and a remaining portion. However, Hannah does not teach an overlay having a tab with a *first shadow line*, as set forth in the claims.

Instead, Hannah teaches an overlay having tabs with a *uniformly distributed layer of granules*. The uniformly distributed layer of granules does not produce a *shadow line*.

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Hannah also fails to teach an underlay having a *second shadow line* and a remaining portion. Instead, Hannah teaches an underlay with a *uniformly distributed layer of granules*. The uniformly distributed layer of granules on the underlay does not produce a *shadow line*. However, the granules on the underlay are darker in color than the granules on the overlay, and a portion of the underlay is exposed to reveal the darker granules, as shown in Hannah's drawings below. Nonetheless, this does not result in an overlay having a tab with a *first shadow line* and a remaining portion, as set forth in the claims.



In response to the foregoing argument, it *appears* that the Examiner asserts that the overlay and underlay of Hannah effectively form tabs and the exposed portion of the underlay forms a shadow line (see page 11 of the Office Action). However, this does not teach an *overlay* with a tab having a shadow line, as set forth in the claims. To this end, Hannah fails to cure the deficiencies in Weaver. In fact, this interpretation teaches away from the claimed invention, which requires the leading edge of the underlay to generally co-align with the leading edge of the overlay.

Corbin teaches a *randomly varying series* of differently colored portions of a granule covered surface. Corbin *fails to teach* an overlay having a tab with a *first shadow line* that is *darker in color* than a remaining portion of the tab. Accordingly, Corbin fails to cure the deficiencies in Weaver and Hannah, as set forth above. Hence,

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Weaver, Hannah, and Corbin, when combined, do not result in a combination including all the limitations of claims 1, 7, and 22. As a consequence, claims 1, 7, and 22 are non-obvious under 35 U.S.C. §103, and should be allowable.

If an independent claim is non-obvious under 35 U.S.C. 103, then any claim depending therefrom is non-obvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Claims 2-6 and 8-11 depend from claims 1 and 7, respectively, and should be allowable for at least the same reasons as claims 1 and 7, as set forth above.

Claims 12-20 are rejected under 35 U.S.C. § 103, as being unpatentable over Weaver in view of Hannah and Corbin.

Claim 12 recites a method of making a laminated roofing shingle. The method comprises the steps of coating a base material, forming a granule-covered sheet, and cutting the granule covered sheet. The granule-covered sheet is formed by applying a layer of granules to the outer surface of the coated base material. Darker granules are applied to portions of the base material corresponding to a leading edge of tabs of an overlay of a laminated shingle and a trailing edge of an underlay of the laminated shingle. Lighter colored granules are applied to remaining portions of the tabs and the underlay so that the leading edge of the tabs and the trailing edge of the underlay are generally darker in color than the remaining portions of the tabs and the underlay. The granule covered sheet is cut to form the overlay and the underlay.

Weaver *fails to teach* steps set forth in claim 12. In particular, Weaver *fails to teach* the step of applying a layer of granules to the outer surface of the coated base material, wherein darker granules are applied to portions of the base material corresponding to a leading edge of tabs of an overlay of a laminated shingle and a trailing edge of an underlay of the laminated shingle. Instead, Weaver teaches the application of a *uniformly distributed layer of granules* to the outer surface of the coated base material.

Hannah fails to cure the deficiencies in Weaver in that Hannah is totally void any teaching of a method of making a laminated roofing shingle. Corbin fails to cure the deficiencies in Weaver and Hannah in that Corbin *fails to teach* the step of

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applying a layer of granules to the outer surface of the coated base material, wherein darker granules are applied to portions of the base material corresponding to a *leading edge of tabs of an overlay* of a laminated shingle and a *trailing edge of an underlay* of the laminated shingle while lighter colored granules are applied to *remaining portions of the tabs and the underlay*. Instead, Corbin teaches away from the claimed invention, which requires the leading edge of the underlay to generally co-align with the leading edge of the overlay.

In view of the foregoing remarks and arguments, it is respectfully submitted that Weaver, Hannah and Corbin, when combined, *fail to teach* the invention recited in claim 12. Hence, claim 12 is non-obvious under 35 U.S.C. § 103 and thus should be patentable.

Claims 13-20 depend from claim 12 and should be allowable for at least the same reasons as claim 12, as set forth above.

Claims 21 and 23 are rejected under 35 U.S.C. § 103, as being unpatentable over Weaver in view of Hannah and Corbin. This rejection is respectfully traversed.

Claim 21 recites an overlay and an underlay. The overlay has a tab with a leading edge having granules thereon, wherein the leading edge is generally *darker* than a remaining portion of the overlay. The underlay has a shadow line and a remaining portion, each having granules thereon, wherein the shadow line is generally darker than the underlay remaining portion.

Weaver *fails to teach* a tab with a leading edge having granules thereon, wherein the leading edge is generally *darker* than a remaining portion of the overlay and an underlay having a shadow line and a remaining portion, each having granules thereon, wherein the shadow line is generally darker than the underlay remaining portion.

Hannah fails to cure the deficiencies in Weaver in that Hannah fails to teach an overlay having a tab with a leading edge having granules thereon, wherein the leading edge is generally *darker* than a remaining portion of the overlay, as set forth in claim

21. Instead, Hannah teaches an overlay having tabs with a *uniformly distributed layer*

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of granules. The uniformly distributed layer of granules does not produce a leading edge that is generally *darker* than a remaining portion of the overlay. Hannah also fails to teach an underlay having a *second shadow line* and a remaining portion. Instead, Hannah teaches an underlay with a *uniformly distributed layer of granules.* The uniformly distributed layer of granules does not produce a *shadow line.* Although the granules on the underlay are darker in color than the granules on the overlay, and a portion of the underlay is exposed to reveal the darker granules, this does not result in an overlay having a tab with a *first shadow line* and a remaining portion, as set forth in claim 21. Moreover, as stated above, Hanna teaches away from the claimed invention, which requires the leading edge of the underlay to generally co-align with the leading edge of the overlay.

Corbin teaches a *randomly varying series* of differently colored portions of a granule covered surface. However, Corbin *fails to teach* an overlay having a tab with a leading edge having granules thereon, wherein the leading edge is generally *darker* than a remaining portion of the overlay, as set forth in claim 21. Moreover, Corbin fails to teach an underlay having a *second shadow line* and a remaining portion. Instead, Corbin teaches a *randomly varying series* of differently colored portions of a granule covered surface. In this way, Corbin fails to cure the deficiencies in Weaver and Hannah, as set forth above. Hence, Weaver, Hannah, and Corbin, when combined, do not result in a combination including all the limitations of claim 21. As a consequence, claim 21 is non-obvious under 35 U.S.C. §103, and should be allowable.

Claim 23 recites an overlay and an underlay. The overlay has a tab with a leading edge, a first shadow line, and a remaining portion, wherein the shadow line is positioned between the leading edge and the remaining portion, and wherein a layer of granules is disposed on the first shadow line and the remaining portion of the tab in a manner whereby the first shadow line is a different color or shade than the remaining portion. The underlay has a leading edge, a second shadow line, and a remaining portion between the leading edge of the underlay and the second shadow line, wherein a layer of granules is disposed on the underlay in a manner whereby the second

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shadow line of the underlay is a different color or shade than the remaining portion of the underlay.

Weaver *fails to teach* a tab with a first shadow line, a remaining portion, and a layer of granules disposed on the first shadow line and the remaining portion of the tab in a manner whereby the first shadow line is a *different color or shade* than the remaining portion.

Hannah fails to cure the deficiencies in Weaver in that Hannah fails to teach a tab with a first shadow line, a remaining portion, and a layer of granules disposed on the first shadow line and the remaining portion of the tab in a manner whereby the first shadow line is a *different color or shade* than the remaining portion, as set forth in claim 23. Instead, Hannah teaches an overlay having tabs with a *uniformly distributed layer of granules*. The uniformly distributed layer of granules does not produce a shadow line that is a *different color or shade* than a remaining portion of the overlay. Hannah also fails to teach an underlay having a *second shadow line* and a remaining portion. Instead, Hannah teaches an underlay with a *uniformly distributed layer of granules*. The uniformly distributed layer of granules does not produce a *shadow line*. Although the granules on the underlay are darker in color than the granules on the overlay, and a portion of the underlay is exposed to reveal the darker granules, this does not result in an overlay having a tab with a *first shadow line* and a remaining portion, as set forth in claim 23. Moreover, as stated above, Hanna teaches away from the claimed invention, which requires the leading edge of the underlay to generally co-align with the leading edge of the overlay.

Corbin *fails to teach* an overlay having a tab with a first shadow line, a remaining portion, and a layer of granules disposed on the first shadow line and the remaining portion of the tab in a manner whereby the first shadow line is a *different color or shade* than the remaining portion, as set forth in claim 23. Instead, Corbin teaches a *randomly varying series* of differently colored portions of a granule covered surface. In this way, Corbin fails to cure the deficiencies in Weaver and Hannah, as set

forth above. Hence, Weaver, Hannah, and Corbin, when combined, do not result in a

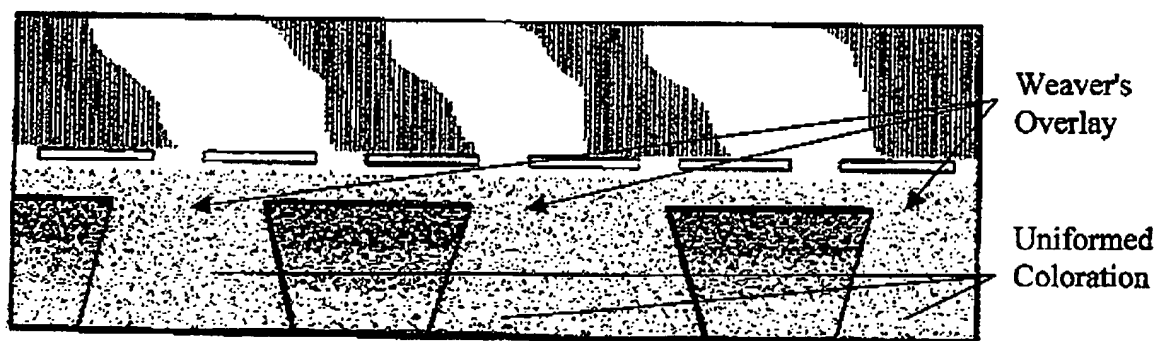
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combination including all the limitations of claim 23. As a consequence, claim 23 is non-obvious under 35 U.S.C. §103, and should be allowable.

Claims 24 and 26-32 are rejected under 35 U.S.C. § 103, as being unpatentable over Weaver in view of Hannah and Corbin. This rejection is respectfully traversed.

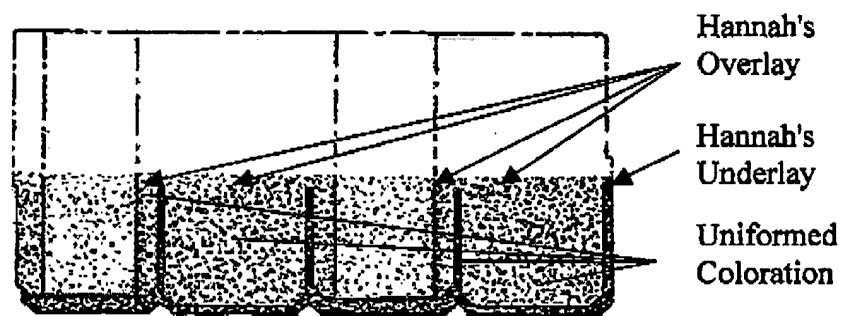
Claim 24 recites an overlay and an underlay. The overlay has a tab in a butt section. The tab has an outer surface with a trailing edge adjacent a headlap section and a leading edge spaced from the trailing edge. The underlay has an outer surface that is positioned adjacent the tab with a trailing edge adjacent the headlap section and a leading edge spaced from the trailing edge. First colored granules adhered to the outer surface of the tab adjacent the leading edge of the tab produce a first colored portion. Second colored granules are adhered to the outer surface of the tab so as to be separated from the leading edge of the tab by the first colored granules. The second colored granules have a different coloration or shade than the first colored granules to produce a second colored portion that is a different coloration or shade than the first colored portion. Third colored granules adhered to the trailing edge of the outer surface of the underlay provide a third colored portion. Fourth colored granules adhered adjacent the leading edge of the outer surface of the underlay having a different coloration or shade than the third colored granules produce a fourth colored portion that is a different coloration or shade than the third colored portion.

Weaver, as shown in the drawing below, fails to teach an overlay having a tab having two colored portions, each being a different coloration or shade than the other.

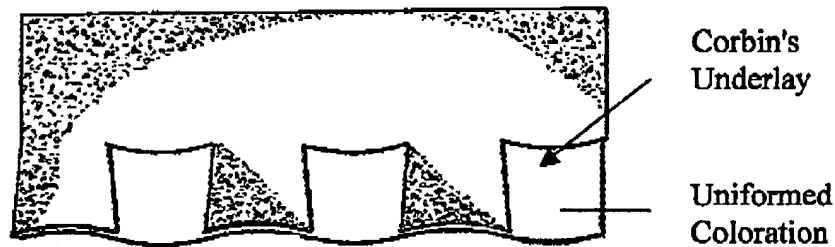


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Hannah, as shown in the drawing below, fails to teach an overlay having a tab having two colored portions, each being a different coloration or shade than the other, and further fails to teach an underlay having two colored portions, each being a different coloration or shade than the other.



Corbin, as shown in the drawing below, fails to teach an underlay having two colored portions, each being a different coloration or shade than the other.



Weaver and Corbin separately teach an overlay having a tab with two colored portions, each being a different coloration or shade than the other, and an underlay having two colored portions, each being a different coloration or shade than the other. However, but for hindsight vision afforded by Applicant's invention, there is no motivation to combine the teachings of Weaver and Corbin, and the references must be viewed without the benefit of impermissible hindsight vision afforded by Applicant's invention. That is to say, Weaver does not teach or suggest that his underlay can attached to an overlay having two colored portions, each being a different coloration or shade than the other. Similarly, Corbin does not teach or

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suggest that his overlay can be attached to an underlay having a tab having two colored portions, each being a different coloration or shade than the other. To this end, the invention of claim 24 is non-obvious under 35 U.S.C. § 103 and thus should be allowable.

Claims 25-33 depend from claim 24 and should be allowable for at least the same reasons as claim 24, as set forth above.

Claims 34-45 are rejected under 35 U.S.C. § 103, as being unpatentable over Weaver in view of Hannah and Corbin. This rejection is respectfully traversed.

Claim 34 is similar to claim 24 in that claim 34 recites adjacent portions of a tab and adjacent portions of an underlay that are a different shade or coloration. Claim 34 should be allowable for at least the same reasons as claim 24, as set forth above.

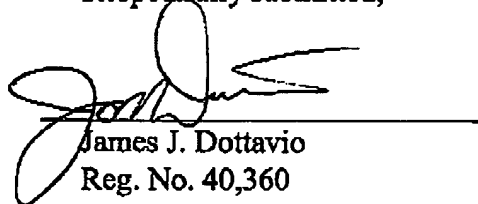
Claims 35-45 depend from claim 34 and should be allowable for at least the same reasons as claim 34, as set forth above.

In view of the foregoing amendments and remarks, Applicant submits that claims 1-45 are allowable. The Examiner is invited to telephone the Applicant's undersigned agent at (740) 321-7168 if any unresolved matters remain, if any questions should arise with respect to the above Remarks, or if the Examiner has any comments or suggestions to place the claims in better condition for allowance.

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Applicant authorizes any fees required pertaining to this response be charged to
Deposit Account No. 50-0568.

Respectfully submitted,



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